



BOX AMENDMENT
Attorney Docket No. 24580

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HUGO, Gerd

Examiner: S. MANLOVE

Serial No.: 09/840,982

Group Art Unit: 1755

Filed: April 25, 2001

For: **COATING WITH SPECTRAL SELECTIVITY**

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith for filing in the U.S. Patent and Trademark Office are the following:

- 1) Transmittal Letter; and
- 2) Response to Restriction Requirement.

The Commissioner is hereby specifically authorized to charge any fee deficiency, or credit any overpayment, in connection with this matter to Deposit Account No. 14-0112.

Respectfully submitted,

NATH & ASSOCIATES

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Date: August 2, 2004

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Title: COATING WITH SPECTRAL SELECTIVITY

RESPONSE TO RESTRICTION REQUIREMENT AND SPECIES ELECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated July 1, 2004, due for reply by August 1, 2004, which fell on a Sunday. This response is being filed on the next business day, Monday, August 2, 2004, and therefore, this response is filed within the time period set by the Examiner.

SUMMARY OF RESTRICTION REQUIREMENT

Election of Groups: The Examiner has required Applicant, under 35 U.S.C. §121, to elect a single Group from the following:

Group I: claims 1-16, drawn to coating; and

Group II: claim 18, drawn to method.

As basis for this restriction requirement, the Examiner contends the inventions are distinct, each from the other, for the following reasons:

Inventions Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed could be used as pigment for paint.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Election of Species: The Examiner has required Applicant, under 35 U.S.C. §121, to elect a single disclosed species from the following:

Species of binder: aqueous dispersions and emulsions;

Species of first pigment: inorganic or organic; and

Species of second pigment: metal, electrically non-conductive materials, and laminated pigments.

PROVISIONAL ELECTION

Applicant provisionally elects with traverse: Group I, claims 1-16, drawn to coating. With respect to the election of species requirement, Applicant provisionally elects the following species: **binder:** aqueous dispersions and emulsion; **first pigments:** inorganic pigments; and **second pigments:** metal or metal alloys. Claim 3 reads on the on the elected species of binder; Claim 4 reads on the elected species first pigments; and claim 6 reads on the

elected species of second pigments.

TRAVERSAL

Applicant respectfully traverses the Examiner's requirement for claim restriction and species election.

First, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if the restriction were not required. See MPEP 803. Regardless of any differences which may exist between the inventions set forth in the different groups, a complete and thorough search for the invention set forth in any one of the groups would require searching the art areas appropriate to the other group. Since a search of each the inventions would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Moreover, given the overlapping subject matter, examination of the claims in this application would not pose a serious burden, because the searches would be coextensive in that a search of any one of the invention Groups I and II would require searching the prior art areas appropriate to the other invention Group.

Finally, Applicant notes that upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

In view of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the requirement for claim restriction and election of species and examine all claims pending in this application.

CONCLUSION

Applicant greatly thanks the Examiner for her response to phone calls by Tanya Harkins concerning the further explanation of the substance of the species election. If the Examiner has any questions or wishes to discuss this matter, he is welcomed to contact the undersigned attorney.

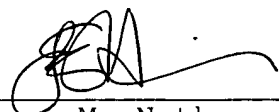
Respectfully submitted,

NATH & ASSOCIATES PLLC

Date:

Aug 2, 2004

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